

REMARKS

Claims 2, 4, 5, 8 and 9 are now pending in this application. Claims 1-7 are rejected. Claims 1, 3, 6 and 7 are cancelled herein. New claims 8 and 9 are added. Claims 2, 4 and 5 are amended herein to clarify the invention, to express the invention in alternative wording, and to address matters of form unrelated to substantive patentability issues.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claims 1, 5/1 and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by the Ogawa reference (US 2003/0025238) or the Ogawa et al. reference (US 2002/0089077).

Claim 4/1 is rejected under 35 U.S.C. §103(a) as obvious over the Ogawa reference (US 2003/0025238) or the Ogawa et al. reference (US 2002/0089077).

Claims 2, 4/2, 5/2 and 6 are rejected under 35 U.S.C. §103(a) as obvious over the Ogawa reference (US 2003/0025238) or the Ogawa et al. reference (US 2002/0089077), and further in view of at least one of Cartwright et al. (US 3,782,428), Birdsall (US 1,827,416) and Corbett (US 2,680,880).

Claims 1, 3/1, 4/1, 5/1 and 6 are rejected under 35 U.S.C. §103(a) as obvious over the the Laurent reference (US 4,963,207) or the Vargo et al. reference (US 2004/0089400) in view of the Böhm et al. reference (US 5,156,781).

Claims 2, 3/2, 4/2, 5/2 and 7 are rejected under 35 U.S.C. §103(a) as obvious over the Laurent reference (US 4,963,207) or the Vargo et al. reference (US 2004/0089400) in view of the Böhm et al. reference (US 5,156,781), and further in view of at least one of Cartwright et al. (US 3,782,428), Birdsall (US 1,827,416) and Corbett (US 2,680,880).

Claims 1, 3, 6 and 7 are now cancelled, and the remaining claims made dependent from newly drafted claim 8, thereby rendering the above rejections moot. However, insofar as the subject matter of new claim 8 reflects that of the cancelled claims 1 and 6, and in the event the Examiner considers asserting the present rejection against the new claims or making the next Office Action final, applicants submit the following remarks relative to the substance of the rejections.

It is respectfully submitted that the subject matter of newly drafted independent claim 8, from which all remaining dependent claims previously pending depend, is not made obvious by the disclosure of any of the cited art of record, either taken alone or in any of the proffered combinations set for in the Office Action, as referenced above.

In particular, it is respectfully submitted that none of the cited references teach or suggest the now-claimed relationship between the timing of a tight contact and a spacing away between a rubber strip and a tire-building drum, and a timing of respective initiation and stopping of an outputting of a rubber strip. As such, a *prima facie* case of obviousness cannot be made in the rejection of newly drafted claim 8 and the claims made dependent therefrom.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection". Clearly, such burden cannot be met as applied to claim 8 as now written.

Thus, it is respectfully submitted that the claims 2, 4, 5 and 8, are not obvious in view of the cited references for the reasons stated above. Allowance of these claims is respectfully requested.

Claim 9 is added and is submitted as patentable over the cited art of record. Independent claim 9 recites subject matter directed to moving a forming nozzle to a pressing position in which the forming nozzle is pressed against an outer surface of a tire-building drum, outputting the rubber strip from the forming nozzle, initiating rotation of the tire-building drum while moving the forming nozzle to a retreated portion in which the forming nozzle is spaced away from the tire-building drum by a predetermined distance, returning the forming nozzle to the pressing position upon completion of a subsequent winding operation, and stopping rotation of the tire-building drum while concurrently stopping the outputting of the rubber strip, which, among other features recited therein, is not believed disclosed in the cited art in the manner as claimed.

Applicants respectfully request a one (1) month extension of time for responding to the Office Action. Please charge the fee of \$120 for the extension of time to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,
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